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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/940,815	09/30/1997	CHRISTOPHER J. STEVENS	PM-421	5323
4743	7590	10/24/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			MAYES, MELVIN C	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/940,815

Applicant(s)

STEVENS, CHRISTOPHER J.

Examiner

Melvin Curtis Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-14, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 4, 8 and 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/8/05, 8/22/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

(1)

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on August 8, 2005 has been entered.

Claim Rejections - 35 USC § 112

(2)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(3)

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said tip member." There is insufficient antecedent basis for this limitation in the claim. Claim 6 should read "said unitary member."

Claim Rejections - 35 USC § 103

(4)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

(5)

Claims 1-3, 5-7, 9-14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-56690 in view of FR2643351 Abstract.

JP 63-56690 discloses a correction tape dispenser comprising tape 11; supply spool 16 from which the tape is fed, take-up spool 17; tip 25 having edge around which the tape is fed; the tip having projections 23 and 24 (retaining means in the form of a pair of projections) adjacent the tip on each side the tip between which the tape is fed; members 18, 19 (tape positioning means) from which the tape passes to and from the tip; and an elongated case 12 enclosing the spools. As shown, the tip edge direction and the feed direction of the tape from the supply spool

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are at an angle of about 450° (Fig 1-3). JP 63-56690 disclose providing the tip 25 with guide channels 23a and 24a (guide means or elements) on either side of the edge but do not disclose providing the tip such that the guide means operate in conjunction with the shape of the tip to twist the tape so that path of the tape around the edge is in a plane substantially perpendicular to the edge and inclined to the feed direction from the supply reel.

FR '351 Abstract teaches that a dispenser for tape is made ergonomic by providing the applicator axis perpendicular to the axis of the reel of tape so that the dispenser can be held like a marker. The tape undergoes a twist of 90° from the reel to the applicator.

It would have been obvious to one of ordinary skill in the art to have modified the correction tape dispenser of JP '690 by providing the tip perpendicular to the axis of the supply spool so that the tape undergoes twist of 90° from the spool to the tip edge, as taught by FR '351 Abstract, to make the dispenser more ergonomic so that it can be held like a marker. By providing the tip and its adjacent guide channels perpendicular to the axis of the supply spool to make the dispenser more ergonomic, the guide channels on each side of the tip would obviously act as guide means or elements on either side of the edge which operate in conjunction with the shape of the tip for twisting the tape so that the path of the tape around the edge is substantially perpendicular to the edge and inclined to the feed direction of the tape leaving the supply spool, as claimed.

The guide channels 23a, 24a as shown in JP '690 have upper linear and parallel ridges around which the tape would pass from the supply spool to the tip edge and from the tip edge to the take-up spool, as claimed in Claims 2 and 3.

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With respect to Claim 6, because members 18, 19 (tape positioning means) and the tip are attached to the case, tape positioning means are obviously attached to the tip via the case.

(6)

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-56690 in view of FR2643351 Abstract as applied to claim 1 above, and further in view of DE 41 01 293.

DE '293 teaches that the tip 72 of an applicator for transferring correcting film is provided with shape which widens toward the edge around which the film passes (Fig. 5a).

It would have been obvious to one of ordinary skill in the art to have modified the correction tape dispenser of the reference as combined by providing the tip with a widening shape toward its edge, as taught by DE '293, as the shape of the applicator for transferring correcting film. Providing the tip with "extension portions" as claimed would have been obvious to one of ordinary skill in the art because DE '293 teaches that it is known in the art of correcting film dispensers to provide the tip around which the film passes with a shape which widens toward the edge.

Allowable Subject Matter

(7)

Claims 4, 8 and 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

(8)


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(9)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
October 19, 2005